

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

In the Official Action, the Examiner objects to the incorporation by reference of the priority document and asks that the specification be amended to include all essential material. In response, the Applicant respectfully submits that the essential material of the priority document is already contained in the specification. Accordingly, it is respectfully requested that the objection to the specification be withdrawn.

In the Official Action, the Examiner rejects claims 1-10 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claim 1, the Examiner argues that the phrases "the opening" and "the other portion" lack antecedent basis. In response, claim 1 has been amended to change the same to --an opening-- and --other portions of the insertion member--, respectively.

Further with regard to claim 1, the Examiner objects to the term "soft" because it is vague and indefinite. In response, claim 1 has been further amended to change "an insertion member having a soft part" to --an insertion member of an endoscope--.

With regard to claims 4-7, the Examiner argues that the same are vague and indefinite and not understandable. With regard to claim 4, the same has been canceled and merged with the features of claims 1 and 10. However, the features of original claim 4 now recite that the positioning member corresponding with the predetermined portion of the insertion member restricts bending of at least a distal 70 cm portion of the insertion member. Accordingly, claim 4 has been canceled thereby rendering the rejection thereof moot. With

regard to claims 5-7, the same have also been cancelled, thereby rendering the rejection thereof moot.

With regard to claim 8, the Examiner argues that "said body tray" lacks antecedent basis. In response, claim 8 has been amended to change "said body tray" to --said tray--. Claim 8 has been further amended to improve its form and readability.

With regard to claim 9, the Examiner objects to the use of the terms "hard" and "soft" as being indefinite. The Examiner also argues that the claim is vague and indefinite because it is unclear what structural relationship is being claimed. In response, claim 9 has been amended to delete such terms. Claim 9 has been further amended to place the same into independent form to recite the insertion member sheathing member in the preamble.

With regard to claim 10, the Examiner argues that the term "soft" is vague and indefinite and the phrase "the other portion" lacks antecedent basis. In response, claim 10 has been amended similarly to that discussed above. Claim 10 has been further amended to improve its form and readability and to include the features of original claim 4 (with the changes as indicated above).

Accordingly, it is respectfully requested that the rejection of claims 1-10 under 35 U.S.C. § 112, second paragraph, be withdrawn. The Applicant respectfully submits that the present amendment is fully supported in the original disclosure. Thus, no new matter has been introduced into the disclosure by way of the present amendment.

In the Official Action, the Examiner rejects claim 10 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,633,758 to Morse et al., (hereinafter "Morse"). Additionally, the Examiner rejects claims 9 and 10 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,361,751 to Hight, III et al., (hereinafter "Hight").

Furthermore, the Examiner rejects claims 1, 2, 4-7, and 9-10 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,759,490 to Malchesky (hereinafter “Malchesky”). Lastly, the Examiner rejects claims 1-10 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,534,221 to Hillebrenner et al., (hereinafter “Hillebrenner”).

In response, independent claims 1 and 10 have been amended to include the features of original claim 4 (rewritten as discussed above). In the Official Action, the Examiner does not specifically indicate where in the references, the features of claim 4 are disclosed. The Applicant finds no disclosure or suggestion of the features of claim 4, now recited in claims 1 and 10 in any of the cited prior art references.

With regard to Morse, as discussed above, the same has been amended to include the features as discussed above. Specifically, claim 4 has been amended to recite that the positioning member corresponding with the predetermined portion of the insertion member restricts bending of at least a distal 70 cm portion of the insertion member. Morse does not disclose or suggest such features.

With regard to Hight, the same discloses a container for disinfecting an endoscope. The Applicant respectfully submits, as discussed above, that claim 9 is no longer directed to an endoscope container for high-pressure steam sterilization but to an insertion member sheathing member. Therefore, the Applicant respectfully requests reconsideration of claim 9 in light of the amendment thereto. In this regard, the Applicant respectfully submits that the coiled portion recited in claim 9 is not disclosed in Hight. With regard to claim 10, as discussed above, the same has been amended to recite that the positioning member corresponding with the predetermined portion of the insertion member restricts bending of at

least a distal 70 cm portion of the insertion member. Hight does not disclose or suggest such features.

With regard to Malchesky and Hillebrenner, the same do not disclose the features now recited in claims 1 and 10, as amended. As discussed above, claims 1 and 10 have been amended to recite that the positioning member corresponding with the predetermined portion of the insertion member restricts bending of at least a distal 70 cm portion of the insertion member. Malchesky and Hillebrenner do not disclose or suggest such features.

With regard to the rejections of claims 1-10, under 35 U.S.C. §§ 102(b) and 102(e), an endoscope container for high-temperature high-pressure steam sterilization having the features described above and as recited in independent claims 1 and 10, as amended, are nowhere disclosed in any of the cited references. Since it has been decided that “anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,”¹ independent claims 1 and 10 are not anticipated by the same. Accordingly, independent claims 1 and 10 patentably distinguish over the cited references and are allowable. Claims 2, 3, and 8 being dependent upon claim 1 are thus at least allowable therewith (claims 4-7 being canceled). As discussed above with regard to claim 9, the same has been rewritten as an independent claim and is now directed to an insertion member sheathing member having features not disclosed or suggested in the cited prior art references. Consequently, the Examiner is respectfully requested to withdraw the rejections of claims 1-10 under 35 U.S.C. § 102(b).

¹ Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

In the Official Action, the Examiner rejects claims 1-10 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent Application No. 09/894,659. The Examiner argues that the claims of the present application are the same as those of U.S. Patent Application No. 09/894,659 with the exception of a sealing lid in U.S. Patent Application No. 09/894,659. The Applicant respectfully disagrees.

The claims of U.S. Patent Application No. 09/894,659 recite a vessel having a pressing force preventing means while the claims of the present application recite a positioning member for restricting bending of a portion of the insertion member of an endoscope. Therefore, the claims of the present application and those of U.S. Patent Application No. 09/919,190 differ significantly in structure. The claims of the present application and those of U.S. Patent Application No. 09/894,659 also differ in objective and solve different problems in the prior art. The objective of the claims of U.S. Patent Application No. 09/894,659 is to minimize deformation of portions of an endoscope caused by pressing forces exerted on the endoscope during high-pressure, high-temperature steam sterilization, while the objective of the claims of the present application is to prevent the insertion portion of an endoscope from being bent at a small radius during high-pressure, high-temperature steam sterilization.

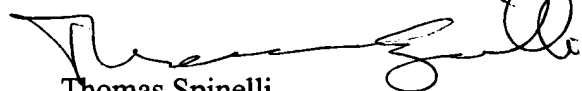
Thus, the Applicant respectfully traverses the Examiner's rejection of claims 1-10 under judicially created doctrine of obviousness-type double patenting and respectfully requests that the same be withdrawn in light of the above remarks.

Lastly, new claims 11-15 have been added by way of the present amendment to further define the patentable invention. The Applicant respectfully submits that new claims

11-15 are fully supported in the original disclosure. Thus, no new matter has been entered into the disclosure by way of the addition of new claims 11-15. Applicants further respectfully submit that at least claims 11 and 15 patentably distinguish over the cited art and are allowable and that claims 12-14 are at least allowable as depending from an allowable base claim (11).

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Thomas Spinelli', with a stylized flourish at the end.

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